REMARKS

Applicant appreciates the courtesies extended by Examiners (1) William Miller; (2) Judy Swann; (3) Terry Melius; and (4) David Reese, during an interview on November 15, 2005 with Applicant's attorneys, Allan A. Fanucci and Jeffrey A. Wolfson. The comments appearing herein are substantially in accord with those presented and discussed during the interview. Furthermore, the interview discussion and remarks presented below are in addition to and do not replace those in the Amendment filed October 19, 2005.

Claims 1-15, 17-18, 21-22, 28-30, 32-41, as amended, and new claims 44-45 are pending for the Examiner's consideration. Claims 16 and 42-43 have been voluntarily canceled without prejudice to Applicant's rights to file a divisional application for the subject matter of those claims, and claim 18 has been amended to remove the language similar to claim 16, as well. Independent claims 1-2 and 13 have been amended to clarify that the invention recited is a finger ring, and not a watch case or portion thereof. Independent claim 39 already recites this feature. Claim 13 has been amended to recite a preferred embodiment with a decoration component including a precious metal that forms a smooth transition with each of the external surface facets of the ring. Claim 28 was amended to recite that the groove or slot extends around the circumference of the ring. Claim 39 has been amended to include the features of claims 42-43 where the decoration component comprising a precious metal forms a second annular ring around the first and wherein the decoration component is recessed from the external surface of the sintered hard material to provide a protective effect. New claim 44 recites that there are at least two external facets on the annular ring of the sintered hard material, with at least one on each side of the slot containing the decoration component. New claim 45 recites that the decoration component is no wider than the slot and that its outer surface forms a smooth transition with the external surface facets of the annular ring of the sintered hard material (*See, e.g.*, Specification at FIGS. 8 and 10-11). As such, no new matter is believed to have been added by virtue of these amendments and new claims.

Rather than reiterate the rejections and deficiencies of the cited references, as already described in the Amendment filed October 19, 2005 and adopted herein, Applicant instead points to the distinctions of certain claim features recited herein, and summarizes the differences between the cited references compared to the Office Action and the Examiners'

position as discussed at the interview. First, there was no motivation to combine the cited references at the time this application was filed—no motivation existed within the references.[1] The Examiners' position is, however, that the claimed ring structure is disclosed separately by Grossman and Bager, and the claimed tungsten carbide material was disclosed as being beneficial in a jewelry article as disclosed in Lederrey.

The fact, however, is that the cited references actually teach away from each other those of ordinary skill in the art would not have been motivated to combine Grossman or Bager with Lederrey. For example, Lederrey fails to teach the ordinary-skilled artisan anything about how to configure a finger ring of tungsten carbide as presently recited, particularly with a slot or groove, and, in fact, *teaches away* from Bager and Grossman (as well as claims 13 and 39 of the present invention) by disclosing that, when complex shapes or grooves are required, a readily workable metal should be used but **not** tungsten carbide.

Second, no reasonable expectation of success in achieving the present invention existed at the time of filing this application based on the cited references.[2] The Examiners allege that the invention is obvious because they look to the structure of Bager or Grossman and the material of Lederrey. This improperly overlooks the full teachings of these cited references. In fact, Grossman and Bager each teach that their structure is achieved only by using a mandrel or otherwise expanding their soft materials, *e.g.*, gold. For example, Bager specifically teaches varying the diameter of the ring body and band relative to each other—after the band has been applied in the channel (Col. 1, lines 23-31). Yet when considering Lederrey as a whole, it clearly teaches forming a face portion of a watch case of tungsten carbide by forming the desired shape before the final sintering—because the material cannot be readily worked or machined after sintering (Lederrey at Col. 1, lines 46-48). Thus, those of ordinary skill in the art would not

[1] *In re Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir., 2002) (finding that the Board of Patent Appeals and Interferences improperly relied upon common knowledge and common sense of person of ordinary skill in art to find invention of patent application obvious over combination of two prior art references, since factual question of motivation to select and combine references could not be resolved on subjective belief and unknown authority).

[2] The Examiners' position is that method steps are completely irrelevant to the article claims recited in the above-noted application. While Applicant agrees that method steps are irrelevant with respect to the claims, on the contrary they are critical to the questions of (1) whether or not a motivation to combine the cited references existed; and (2) whether or not a reasonable expectation of success in achieving the claimed invention existed, before the present invention. Failure to consider the totality of the teachings of the cited references—including the methods of achieving the structures of those references—results in an improper hindsight picking and choosing of features using the present invention as a template.

have expected that tungsten carbide materials could have been used in the ring structures noted in Grossman or Bager.

In fact, the expectation would be just the opposite, namely that it was expected that a predominantly tungsten carbide material would **not** be susceptible to the: (a) pressing; (b) collapsing of the side walls; or the (c) contracting, required by Bager or Grossman to provide the presently claimed ring structure. Even if a motivation to combine the cited references existed, which it did not, the combination of cited references still fails to teach those of ordinary skill in the art the method by which a larger inlaid band can be fitted into a sintered tungsten carbide material selected from Lederrey's watch structure. Indeed, Lederrey itself teaches that materials containing tungsten carbide *cannot be effectively machined after being sintered by normal means* (*See, e.g.*, Col. 1, lines 46-49). Moreover, nothing in the combined cited references enables those of ordinary skill in the art to attain the claimed ring structures. The known problems of working with tungsten carbide materials were not readily solved based on the cited references, and certainly such a hard material would not have been—and was not—reasonably expected to be substituted for noble metal(s) to provide a ring according to Bager or Grossman in view of Lederrey.

In response to this understanding of the prior art, the Examiners alleged that Applicant was arguing patentability based on methods of preparing the invention, and that those methods, while patentable in their own right as evidenced by the allowance and patenting of the four companion applications, do not impart patentability to the present article claims. Applicant agrees that the present claims define article features and not method steps, but, as noted above, that the methods taught by the cited references must be considered in determining whether one of ordinary skill in the art would have been motivated to combine the cited references and in whether a reasonable expectation of success existed in achieving the claimed structure based on the cited references. To advance the interview, the parties decided to agree to disagree on this point. Applicant has, however, identified additional structural features in the claims that are patentable even over an improper combination of the cited references, as discussed herein and in the Amendment submitted October 19, 2005. Also, Applicant has submitted and is supplementing his Declaration to provide evidence in support of the patentability of these claims.

In spite of the lack of a *prima facie* case of obviousness based on the cited references, the West Declaration submitted on April 25, 2005 rebuts even a *prima facie* case of

obviousness by demonstrating the surprising and unexpected commercial success with the claimed finger rings in spite of the alleged obviousness of the invention. In fact, in the well over ***30 years*** since Lederrey issued to allegedly show those in the art a superior material to use in the rings of Grossman and Bager, not a single ring according to the claims was commercialized to the best of Applicant's knowledge (West Declaration at ¶ 7). This commercial success further demonstrates that no motivation to combine the cited references existed and that no reasonable expectation of success existed to achieve the claimed inventive finger rings.

A Supplemental Declaration of Trent West ("Supplemental West Declaration") has been submitted–as requested during the interview–to confirm that the number of rings has increased over time in relation to the gross revenues and the net revenues (Supplemental West Declaration at ¶ 5). Thus, it has now been shown that the commercial success was not in any way due to substantial alterations in the price per ring. Moreover, the Supplemental West Declaration further emphasizes that this success has come in spite of copying by others, in spite of the decreased price of the copied inventive rings, and in spite of the extremely long time of almost ***30 years*** for others to invent and commercialize the claimed invention—which did not occur until the present invention was commercialized (*Id.* at ¶ 6). As a reminder, before commercial sales according to the invention, there were not any tungsten-carbide jewelry rings available for sale anywhere to the Declarant's knowledge (West Declaration at ¶ 7). This is further emphasized by the fact that no prior art references disclosing this type product have been cited, nor is Declarant/Applicant aware of any, despite the Patent Office's effort at reviewing patents going back for well over 30 to as many as 80 years in the past.

Therefore, the West Declaration clearly states that *no market existed* for the claimed articles before they were made commercially available for sale and that these claimed rings "were 100% of the market" initially after being made available until others began copying (*Id.*). Indeed, the West Declaration and Supplemental West Declaration together rebut even a *prima facie* case of obviousness, such as over the cited references in view of Lederrey described in the pending Office Action. Should the Patent Office identify a legitimate concern regarding the persuasiveness of the West Declaration, Applicant will submit any further necessary Declarations that should be able to address any such alleged deficiency. Therefore, Applicant now believes all claims to be in condition for allowance.

Moreover, a few specific claims warrant additional discussion because of additional features that are clearly not shown even if Grossman or Bager were improperly combined with Lederrey. Claims 1-2 recite an external surface facet that extends concentrically and continuously around the circumference without variations in width, while Lederrey *teaches away* from such a structure by virtue of its rectangular shape or other extending portion(s). Claims 2 and 34 further recite a cylindrically shaped exterior portion between first and second frusto-conical portions or rounded portions, respectively, and even the combination of cited references fails to teach this structure. Claim 9 recites at least one additional external surface is present on the finger ring and comprises at least one or more different finishes to provide unique reflection characteristics to the article. Nothing in Lederrey suggests different finishes on the tungsten carbide material, and nothing in any of the cited references provides motivation or enablement to permit one of ordinary skill in the art to achieve this claimed structure. Indeed, Lederrey teaches *only* polished tungsten carbide surfaces—and that is the benefit relied on by the Office Action to suggest the claimed tungsten carbide ring structures.

In addition to the patentably distinct features of claim 1 discussed above, claim 13 further recites that the decoration component is mechanically fit[3] with the hard material to hold the precious metal therein wherein the surface of the precious metal forms a smooth transition with the external surface of each facet. Because Bager and Grossman require bending of the "edge facets" (Grossman feature 4; Bager feature 8), these references fail to teach (a) a continuous and concentric external facet, and (b) a smooth transition from the external facet to the decoration component, each as presently recited. Lederrey fails to remedy these deficiencies as well, in that it teaches only a portion of a watch case but not a smooth transition of concentric and continuous external surface facets. Dependent claim 45 also recites this smooth transition of the decoration component to the opposing external surface facets of the finger ring.

Claim 39, in addition to the distinctions noted above for claim 1, recites a decoration component comprising a recessed precious metal disposed in the slot to provide a substantially different visual effect to the article. This can surprisingly and unexpectedly advantageously minimize contact of the outer surface with any object that contacts the finger ring. Even the improperly combined references fail to teach this feature.

Moreover, claims 40-41 recite a metal material or a hardening resin component, respectively, that is disposed in the slot between a portion of the annular ring and the decoration component to facilitate retention of the decoration component therein. Bager specifically discloses that it obtains its ring without solder in the groove (Bager at Col. 2, lines 10-13). Grossman specifically teaches that no solder or materials should be used to retain the inlay in its recessed channel (Col. 1, lines 23-25). This is a specific object of Grossman's invention. In fact, Grossman teaches that its invention would be *rendered completely inoperable* by including such a material between the inlay and the ring body (Col. 3, lines 19-25). This is because including other material between the inlay and ring body would cause the bottom of the channel not to form a background for the band, because another material would run beyond the side edges and it would substantially if not wholly fill the spaces. Lederrey fails to remedy this deficiency, in part because it is not even a finger ring but for several additional reasons including the lack of a slot or groove, the lack of a precious metal decoration component, etc. Thus, for these reasons, Applicant respectfully requests that this rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn because no *prima facie* case of obviousness has been stated on the record based on the cited references or because even a *prima facie* case has been rebutted by the West Declaration and Supplemental West Declaration.

Thus, Applicant now believes all claims to be in condition for allowance. The Examiners did not fully agree with Applicant's positions and stated that a further search will be made. In order to fully develop a record for appeal as to any non-allowed claims, Applicant has presented claims that he believes to be patentable, and further appropriate action will be taken after the Examiner's response is received.

Respectfully submitted,

11/28/05
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[3] The term "mechanically fit" was stated by the Examiners to refer to a process feature that is provided no patentable weight. On the contrary, this is a structural feature that recites the decoration component and annular finger ring are held together, *e.g.*, without adhesive.